

ESTTA Tracking number: **ESTTA201850**

Filing date: **04/01/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Serco Inc.		
Entity	Corporation	Citizenship	New Jersey
Address	2650 Park Tower Drive Suite 800 Vienna, VA 22180 UNITED STATES		

Attorney information	Shari L. Klevens McKenna Long & Aldridge LLP 1900 K Street, N.W. Washington, DC 20006 UNITED STATES mlaip@mckennalong.com, sklevens@mckennalong.com Phone:202-496-7500
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Applicant Information

Application No	77277569	Publication date	03/11/2008
Opposition Filing Date	04/01/2008	Opposition Period Ends	04/10/2008
Applicant	Caskey Consulting Inc. 1413 4th Street SW Washington, DC 20024 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2007/01/00 First Use In Commerce: 2007/01/00
All goods and services in the class are opposed, namely: Instruction in the field of business and employment training; training services namely, employment training and business training; providing a website that features informal instruction on employment training and business training

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SMT+AR		
Goods/Services	Courses, instruction, and training on effective supervision, evaluations and performance assessments for government employees; educational and instructional materials on effective supervision, evaluations, and performance assessments for government		

	employees.
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Related Proceedings	Opposition filed on this date for ORE+, serial number 77/271,763
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Attachments	SMT AR.PDF (5 pages)(141674 bytes) EX001.PDF (8 pages)(283072 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/sklevens/
Name	Shari L. Klevens
Date	04/01/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In The Matter Of Trademark Application Serial No. 77/277,569
For the Mark SMT+AR
Published in the Official Gazette on March 11, 2008

Serco Inc.)	
)	
Opposer,)	
)	Opposition No.
vs.)	
)	
Caskey Consulting, Inc.)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION FOR SMT+AR MARK

Serco Inc. (“Serco”), the Opposer, is a New Jersey corporation whose principal place of business is 2650 Park Tower Drive, Suite 800, Vienna, Virginia 22180. Serco believes that it will be damaged by registration of the SMT+AR mark (“trademark at issue”) as is more fully described below and hereby opposes same. The grounds for opposition are as follows:

1. On or about June 9, 2005, Serco¹ entered into a Consultant Agreement (“Agreement”) with Dave Caskey of Caskey Consulting, Inc. (“Caskey”), the Applicant in the referenced application. A true and correct copy of the Agreement is attached hereto as Exhibit 1.
2. The Agreement provides that Caskey would provide “expertise in Supervisory Skills” to Serco and that Caskey would be assigned tasks by John Brundage of Serco. See Exhibit 1 at 1.

¹ The Consultant Agreement was executed by Resource Consultants, Inc. which was later merged into Serco Inc.

3. The Agreement further states that “[i]t is agreed that any and all drawings, data, and documentation prepared by [Caskey] in performance of the work under this Agreement is the exclusive property of [Serco]. In addition, [Serco] shall have unlimited rights to such drawings, data, and documentation.”

4. One of the tasks assigned by Serco under the Agreement was to assist Serco with the preparation of a self-assessment tool, comprising the course materials for a training on effective supervision, evaluations and performance assessments for U.S. government employees.

5. Pursuant to the Agreement, Caskey and Serco prepared the course materials for a training on effective supervision, evaluations and performance assessments for government employees (“course materials”) in 2005.

6. Beginning in early 2007, the course materials contained the term “SMT+AR”, which is an acronym for: (1) Specific; (2) Measurable; (3) Time bound; and (4) Aligned; (5) Realistic.

7. Consistent with the language of the Agreement, which stated that Serco would have “unlimited rights to such drawings, data, and documentation,” Serco and Caskey included a footer on the first page of the course materials that read “Serco Proprietary Information.”

8. After the course materials had been finalized, Serco issued several proposals to the U.S. government in response to Requests for Proposals seeking courses, instruction, training, and documentation on effective supervision, evaluations, and performance assessments for government employees.

9. Serco was the prime contractor and the party affiliated with the SMT+AR mark in the proposals. David Caskey was merely identified in Serco’s proposals as a potential consultant to Serco if Serco was awarded the related government contracts.

10. Thus, prior to early 2007, upon information and belief, Caskey did not use the SMT+AR marks on any goods and services and did not use the SMT+AR mark on his own as a source identifier for any goods or services.

11. Because the Agreement specifically stated that any drawings, data, and documentation would be the exclusive property of Serco, any trademark rights arising out of the course materials belong to Serco. Indeed, although Serco contends that Caskey never used the SMT+AR mark in commerce as a trademark, even if Caskey did use the SMT+AR mark, any rights to such mark that he may have had were transferred to Serco pursuant to the Agreement.

12. In marketing its services to the U.S. government, Serco used the trademark at issue as a source identifier for its own goods, namely courses, instruction, and training on effective supervision, evaluations and performance assessments for government employees and the related course materials.

13. In light of the above, Serco is the exclusive owner of the SMT+AR mark in the United States. It has continuously used the mark in interstate commerce throughout the United States since at least as early as early 2007. If Caskey has used the SMT+AR mark since that date, then such use post dates Serco's use, and Serco is the senior user.

14. Serco has offered its goods and services to the public extensively and continuously under the SMT+AR mark through various channels of trade. By reason of such distribution and advertising, the public has come to recognize marks bearing the words SMT+AR as signifying goods and services offered by Serco. Serco has established extensive goodwill in connection with the offer of goods and services in association with the SMT+AR mark.

15. On September 12, 2007, Applicant Caskey filed a trademark application with the United States Patent and Trademark Office for the SMT+AR mark, alleging a date of first use of

January 2007. Caskey filed its U.S. trademark application in International Class 041 for the following goods and services: “Instruction in the field of business and employment training; training services namely, employment training and business training; providing a website that features informal instruction on employment training and business training.”

16. If Caskey is able to register the trademark at issue, such registration is likely to cause confusion, or to cause mistake, or to deceive.

17. Because use of the trademark at issue by Caskey is confusingly similar to Serco’s use of the same mark and because the goods and services associated with the marks are identical or similar, registration of the trademark at issue would interfere with Serco’s use of its referenced mark, and use or registration of the trademark at issue will cause damage to Serco.

18. By reason of the foregoing, Serco believes and submits that it will be irreparably damaged by Applicant’s registration of the trademark at issue.

WHEREFORE, Opposer requests that Application Serial No. 77/277,569 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

POWER OF ATTORNEY

Serco has appointed Shari L. Klevens (a member of the District of Columbia and Virginia bars), and William T. O’Brien (a member of the District of Columbia and Maryland bars) to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith.

Please charge the fees for this Opposition, in the amount of \$300, to undersigned’s Deposit Account, No. 502157.

Respectfully submitted,

/slklevens/

Shari L. Klevens
William T. O'Brien
McKenna Long & Aldridge LLP
1900 K Street, N.W.
Washington, D.C. 20006
(202) 496-7500

Attorneys for Opposer Serco Inc.

Dated: April 1, 2008

EXHIBIT 1



CONSULTANT AGREEMENT 05-030

09 June, 2005

Dave Caskey
Caskey Consulting
1413 4th Street SW
Washington , DC 20024

Resource Consultants, Inc. (RCI) is pleased to offer you a Consultant Agreement to furnish professional consulting services and products to RCI. Your consulting assignments shall encompass expertise in Supervisory Skills. Performance shall be in compliance with Attachment "A". Your tasks will be assigned to you by the following RCI official(s):

John Brundage
Phone: 703.418.1050 x254
Email: John. Brundage@ serco.com

As consideration for these consulting services, we agree to the following terms and conditions:

* TERM: This agreement is effective for the period from 13 June 2005 through 12 June 2006. Any extensions to this period of performance may be made as a result of the mutual agreement of the parties as expressed in a written bilateral modification hereto.

* CONSIDERATION: RCI will pay for your services at the rate of \$ 135.00 per hour for time actually performed in accordance with written Task Assignment Records, as may be issued by the aforesaid official representative of RCI. In addition, should travel other than that between your residence and normal place of business be required on your part in connection with your consulting assignments, RCI shall reimburse you be in accordance with the JTR (FAR clause 31.205-46) associated with your transportation and subsistence, provided however that you received prior express written authorization from the aforesaid RCI official.

* TERMINATION: This agreement is terminable at will by either party giving the other party ten (10) calendar days written notice. However, RCI has the right at its own discretion to order the immediate discontinuance of work on any tasks or projects on which you may be working. In such an event, RCI shall notify you as to whether any additional work may be assigned to you in the future, or that effective ten (10) days from such notice the Agreement shall terminate. In such

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latter event you will be paid the actual cost incurred during your work performance up to the point of appropriate notice to discontinue effort, provided, however that such costs must be verifiable and, in the case of travel, transportation, and subsistence costs, in accordance with the express authorization of the aforesaid RCI official.

* TASK ASSIGNMENT RECORDS: RCI Subcontracts shall be solely responsible for the issuance of any Task Assignment Records and Authorizations which may be issued to you. You are not authorized under any circumstances to perform work under this agreement without a fully executed Task Assignment Record.

Your Task Assignment Record (TAR) shall provide the number of man-hours required to perform the specified work. The price shall be based upon the availability of funds and include the number of estimated hours and the hourly rates set forth under the "Consideration" provision contained herein. The costs of any travel required shall be estimated by you in accordance with Federal Travel Regulations or Joint Travel Regulations as applicable, which shall be included as an element of the Material (ODC) ceiling.

Task Assignment Records shall state the technical and deliverable requirements of the work to be performed, and at the minimum include the following information: (1) Statement of Work; (2) Delivery Schedule; (3) Any required travel; and (4) Man-Hour, Labor, and ODC Ceilings.

You are not authorized to exceed the approved Task Assignment Record Labor or ODC ceiling values.

RCI reserves the right to inspect the quality of the deliverables submitted by you in accordance with the TAR, and to return any products of unsuitable quality to you for rework at no additional cost to RCI. In the event that you refuse to rework the products to the required quality, RCI reserves the right to perform the required effort itself, or to contract with another entity for the services, and to withhold from payment to you, for work rejected by RCI as unsuitable.

* INVOICING The Consultant will submit an invoice to the Contractor at 2650 Park Tower Drive, Suite 800, Vienna, VA 22180 Attn: Subcontracts Invoices should be submitted not later than the fifth (5th) of the current month for the preceding month's efforts. The invoice must include the following data/information:

- Consultant Name
- Invoice Number
- Invoice Date
- Period of Performance of work performed
- Charge Number (See TAR)
- Hours & Rate per Hour
- Cumulative Hours to Date

- Total Travel and accompanying back up documentation attached (Hotel, Air, Car, etc...receipts)
 - Cumulative Travel to Date
 - Grand Total of Labor and Travel (both current and cumulative)
1. Travel must be in accordance with the JTR (FAR clause 31.205-46) and authorized in advance by the RCI technical POC.
 2. Electronic transmittal is encouraged (email – subcontracts@resourceconsultants.com)
 3. Invoices submitted to RCI are subject to the provision of the False Statements Act (62 Stat. 749) and the False Claims Acts (96 Stat. 978 and 62 Stat 698) which statutes carry penalties, fines and/or prison terms.
 4. Payment Terms - Net 45

* SUBSISTENCE PER DIEM CEILINGS: No actual costs in excess of the applicable per diem rates specified in the Federal Travel Regulations and Joint Travel Regulations shall be reimbursed by RCI to the consultant. By law such costs are unallowable under Federal Government contracts. RCI does not, either directly or indirectly, authorize the consultant to incur costs in excess of the above noted per diem ceilings while engaged in official travel under the terms of this Agreement.

RCI reserves the right upon reasonable notice to examine your books and records relating to your incurred costs for this agreement and for a period of up to three years following the payment date of your final invoice.

* USE OF YOUR RESUME: With respect to proposals prepared by RCI, you agree to grant to us permission to use your qualifications resume subject to your prior agreement . If RCI does not have a copy of your current resume on file, a resume must be submitted with the signed Agreement for final approval.

* INDEMNIFICATION AND INSURANCE: You hereby agree to indemnify, defend, and hold RCI harmless from and against all claims and actions, as well as all expenses including legal fees, incidental to such claims and actions based upon or arising out of damaged property or injuries or deaths to persons which are either caused by or contributed to by you or your agents during the performance of work under this agreement. You are at all times an independent contractor. Accordingly, as a Sole Proprietor, you will maintain insurance for your professional actions in accordance with state and Federal Requirements, which ever is the more stringent of the two. (i.e. professional liability insurance, comprehensive automobile liability insurance etc.) Please note that Worker's Compensation is the Sole Proprietor's responsibility. A copy of all applicable insurance policies will be provided upon request. The preceding list of responsibilities is for example only, and is neither limiting nor all inclusive.

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* DATA: It is agreed that any and all drawings, data, and documentation prepared by you in performance of work under this Agreement is the exclusive property of RCI. In addition, RCI shall have unlimited rights to such drawings, data, and documentation. Under no circumstances shall any such data be transferred or communicated to any party other than a current RCI employee.

You also understand and agree that all data provided to you or of which you become aware during the course of your performance under this Agreement shall be considered to be commercially valuable proprietary data which is the exclusive property of RCI. Such data shall be used for no purpose other than for performance under the contract. Under no circumstances shall any such data be transferred or communicated to ANY unauthorized party. Any person not an employee of RCI is included in the definition of an unauthorized party. The obligations of the consultant under this paragraph which prohibit the transfer of proprietary data shall survive the termination of this Agreement for a period of one (1) year from the date of termination. Upon notification of termination of this Agreement, all documents in the possession of the consultant shall be returned to RCI prior to any final payment due under this Agreement.

* SUBSTITUTION: You agree that you will personally perform the services required under this Agreement. No assignment of this Agreement or substitution of another individual or company for yourself will be made without the express written approval of the aforesaid RCI official.

* FACILITIES: It is contemplated that the nature of your services will be accomplished independent of any use of RCI facilities. Therefore, except at the sole option of RCI, RCI facilities and equipment shall not be made available to you for the performance of your services. Notwithstanding the foregoing, you are not prohibited from entering RCI facilities for the conduct of business meetings incidental to the performance of assigned tasks (e.g., progress reviews and problem resolution meetings) or administrative matters (e.g., submission of invoices and submission of data deliverables).

* STANDARDS OF CONDUCT CLAUSE: Consultants shall at all times comply with existing laws and Government regulations of the United States and any other country in which Consultant is acting on behalf of RCI, and shall at all times behave professionally and ethically. Consultant specifically warrants and represents that Consultant has not paid or agreed to pay, nor will Consultant pay or agree to pay, any gratuities or kickbacks in connection with this Agreement. Consultant specifically warrants and represents that no political contributions have been made or are to be made in connection with any orders solicited for the account of RCI. The Consultant shall comply with all Federal regulations which are intended to be applicable to Consultants, whether or not such regulations are in effect at the time of execution of this Agreement.

* INDEPENDENT CONTRACTOR STATUS: It is agreed by all parties hereto that the relationship of Consultant, when providing associated services to RCI hereunder, is at all times that of an independent contractor, and that Consultant is not in any way to be considered as an employee or agent of RCI.

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* LIMITATION OF AUTHORITY: At no time during the term of this Agreement shall Consultant make any commitment or representation which would in any way obligate or bind RCI without specific authorization from RCI.

* CONFLICTS OF INTEREST:

- (a) Consultant during the term of this Agreement and for twelve (12) months following the expiration of this Agreement, shall not, without prior written approval from RCI:
1. establish corporate entities whose products or services are in direct competition with RCI;
 2. recruit current employees or consultants of RCI for duties or employment with other firms or with consultant without the express written consent of RCI;
 3. represent a conflict of interest without prior disclosure to RCI.

This agreement is the complete understanding of the two parties. In addition Consultant in executing this document verifies full compliance with Attachments "A". All prior written and oral understandings and agreements are incorporated herein. Modifications to this Agreement may be made only by written amendments executed by both parties.

Dave Caskey
Caskey Consulting
1413 4th Street SW
Washington , DC 20024

Resource Consultants, Inc.
2650 Park Tower Drive
Suite 800
Vienna, VA 22180

Dave Caskey Date
Consultant

Sally Neal Date
Subcontract Management

Other Required Information:

Tax Identification Number
Telephone Number
Fax Number
Email Address

141-60-3014

202.841.4415

202.517.9121

dave@caskeyconsulting.com

3/31/2008

ATTACHMENT A

1. Review SERCO developed Supervisory Skills course and provide written comments, and recommendations for improvement. Comments will be supplied in a form that the course developers can understand and apply with little or no additional effort. Further comments should be a combination of annotations to course materials and a formal summary in a Word document.
2. This effort should not exceed 16 hours.

June 7, 2005

* **LIMITATION OF AUTHORITY:** At no time during the term of this Agreement shall Consultant make any commitment or representation which would in any way obligate or bind RCI without specific authorization from RCI.

* **CONFLICTS OF INTEREST:**

- (a) Consultant during the term of this Agreement and for twelve (12) months following the expiration of this Agreement, shall not, without prior written approval from RCI:
1. establish corporate entities whose products or services are in direct competition with RCI;
 2. recruit current employees or consultants of RCI for duties or employment with other firms or with consultant without the express written consent of RCI;
 3. represent a conflict of interest without prior disclosure to RCI.

This agreement is the complete understanding of the two parties. In addition Consultant in executing this document verifies full compliance with Attachments "A" and "B". All prior written and oral understandings and agreements are incorporated herein. Modifications to this Agreement may be made only by written amendments executed by both parties.

Dave Caskey
Caskey Consulting
1412 4th Street SW
Washington, DC 20034

Dave Caskey
Consultant

06.10.05
Date

Resource Consultants, Inc.
2650 Park Tower Drive
Suite 800
Vienna, VA 22180

Sally Neal
Subcontract Management

06.10.05
Date

Other Required Information:

Tax Identification Number
Telephone Number
Fax Number
Email Address

141-60-3014
202.841.4415
202.517.9121
dave@caskeyconsulting.com

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